IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Continuation Application of:)
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Karl L. GINTER, et al.)
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Serial No.: 09/335,465) Group Art Unit: 2767
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Filed: June 17, 1999) Examiner: G. Barron, Jr.
)
For: SYSTEMS AND METHODS FOR)
SECURE TRANSACTION)
MANAGEMENT AND ELECTRONIC)
RIGHTS PROTECTION)

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

PRELIMINARY AMENDMENT

Prior to the examination of the above application, please amend this application as follows:

IN THE CLAIMS:

Please cancel claims 1-90 and add new claims 91-139 as follows:

91. A method for performing the following steps within a virtual distribution environment located at a first site, comprising one or more electronic appliances and a first secure container, the first secure container containing first protected information and having associated a first control set, the method comprising:

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using a control from the first control set to govern
an aspect of use of the first protected information
while the first protected information is contained
within the first secure container;

creating a second secure container having
associated a second control set for governing an
aspect of use of protected information contained
within the second secure container;

incorporating a first portion of the first protected
information in the second secure container, the
first portion made up of some or all of the first
protected information;

storing identification information at least in part
identifying the first portion, the storing being
governed at least in part by a control from the first
control set; and

transmitting the identification information to a
second site, the transmission being governed at
least in part by a control from the first control set.

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91.   The method of Claim 91, in which the first secure container further

contains a third secure container having associated a third control set, the third

secure container containing the first protected information and

> the step of incorporating the first portion in the second
>
> secure container includes copying or removing the first
>
> portion from the third secure container.

92.   The method of Claim 91, in which the step of creating a second secure

container includes:

> creating the second control set by incorporating at least one control
>
> from the first control set.

93.   The method of Claim 93, in which the step of incorporating at least one

control from the first control set is accomplished in a secure manner.

94.   The method of Claim 92, in which the step of creating a second secure

container includes:

creating the second control set by incorporating at least one control from the third control set.

95.   The method of Claim 95, in which the step of incorporating at least one control from the third control set is accomplished in a secure manner.

96.   The method of Claim 92, in which the step of creating a second secure container includes:

creating the second control set by incorporating at least one control not found in the first control set or the third control set.

98.   The method of Claim 97, in which the step of incorporating at least one control not found in the first control set or the third control set is accomplished in a secure manner.

99.   The method of Claim 91, in which the step of creating a second secure container is governed at least in part by at least one control contained within the first control set.

100.   The method of Claim 92, in which the step of creating a second secure container is governed at least in part by at least one control contained within the third control set.

101. The method of Claim 92 in which the step of creating a second secure container is governed at least in part by at least one control not contained within the first control set or the third control set.

102. The method of Claim 92, further comprising:

copying or transferring the second secure container from the first site to a third site located remotely from the first site.

103. The method of Claim 102, in which the first site is associated with a content distributor.

104. The method of Claim 103, in which the third site is associated with a user of content.

105. The method of Claim 104 further comprising the following step:

the user directly or indirectly initiating communication with the first site.

106. The method of Claim 104, in which the second control set includes one or more controls at least in part governing the use by the user of at least a portion of the first portion of the first protected information.

107. The method of Claim 104, in which the second control set includes one or more controls at least in part governing the price to be paid by the user for use of at least a portion of the first portion of the first protected information.

108. The method of Claim 104, in which the second control set includes one or more controls at least in part governing or specifying an auditing method to be used in connection with use by the user of at least a portion of the first portion of the first protected information.

109. The method of Claim 108, wherein at least some auditing performed in accordance with the auditing method is performed at the third site.

110. The method of Claim 108, in which the second control set includes one or more controls at least in part specifying one or more allowed clearinghouses to receive payment information from the user for use of at least a portion of the first portion of the first protected information.

111. The method of Claim 108, in which the second control set includes one or more controls at least in part specifying information to be provided by the user in return for use of at least a portion of the first portion of the first protected information.

112.   The method of Claim 111, further comprising the step of:

encrypting at least a portion of the information to be provided by the user.

113.   The method of Claim 102, further comprising:

establishing a level of compensation required for at least one of (a)

the copying or transferring step, or (b) at least one aspect of use at

the third site of at least a portion of the first portion of the first

protected information, and

calling a budget method to establish whether one or more budgets

associated with the user are sufficient to satisfy the required

compensation.

114.   The method of Claim 113, further comprising:

blocking the copying or transferring step and/or the at least one aspect of

use if the budget method establishes that the one or more budgets

associated with the user are not sufficient to satisfy the required

compensation.

115.   The method of Claim 113, in which the budget method is governed at least

in part by one or more controls contained in the first control set.

116.   The method of Claim 113, in which the budget method is governed at least in part by one or more controls contained in the third control set.

117.   The method of Claim 116, in which the budget method is also governed at least in part by one or more controls contained in the first control set.

118.   The method of Claim 92, in which the creation of the second secure container further comprises using a template which specifies one or more of the controls contained in the second control set.

119.   The method of Claim 92, in which the creation of the second secure container further comprises using a template which specifies one or more attributes of the second secure container.

120.   The method of Claim 102, in which the creation of the second secure container further comprises using a template which specifies one or more of the controls contained in the second control set.

121.   An electronic appliance located at a first site comprising:

a memory storing a first secure container having associated a first rule set and containing first protected information; and

a secure processing unit comprising

means for creating a second secure container having

associated a third rule set, the means further comprising

means for copying or removing a first rule from the

first rule set, and

means for incorporating the first rule in the second

rule set;

means by which a rule from the first rule set governs, at least

in part, the means for creating a second secure container;

means for copying or removing at least a first portion of the

first protected information from the first secure container;

means for copying or transferring the first portion of the first

protected information from the first secure container to the

second secure container,

the means for copying or transferring operating at

least in part under the control of the first rule set;

memory means for storing identification information at least

in part identifying the first portion of the first protected

information; and

telecommunications means for communicating the

identification information to a second site located remotely

from the first site.

122.   An electronic appliance of Claim 121, further comprising means by which

a rule from the first or second rule set at least in part governs use of the

telecommunications means communicating identification information to the

second site.

123.   A data processing arrangement comprising:

a first secure container containing first protected information and having

associated a first rule set governing use of the first protected information;

means for creating and storing a second secure container having associated

a second rule set; and

means for copying or transferring at least a portion of the first protected

information and a third rule set governing use of the portion of the first

protected information to the second secure container, the means for copying

or transferring including

means for storing identification information relating to the copied or

transferred first protected information portion, and

means for communicating the stored identification information to a remote site.

124. The data processing arrangement of Claim 123, further comprising:

means for applying a rule from the first rule set to at least in part govern the means for storing identification information and the means for communicating.

125. The data processing arrangement of Claim 124, further comprising:

means for applying a rule from the second rule set to at least in part govern the means for storing identification information and the means for communicating.

126. The data processing arrangement of Claim 124, in which the second rule set includes a rule from the first rule set.

127. A method comprising the steps of

creating a first secure container having associated a first rule set and containing first protected information;

storing the first secure container in a first memory;

creating a second secure container comprising a second rule set;

storing the second secure container in a second memory;

copying or transferring at least a first portion of the first protected

information to the second secure container, the copying or transferring

step being at least in part governed by a first rule from the first rule set;

in compliance with the first rule, storing information at least in part

identifying the first portion; and

in compliance with the first rule, communicating at least a portion of the

identification information to a remote site.

128.   The method of Claim 127, wherein the steps of creating the second

secure container, and copying the first portion of the first protected information,

are securely performed by one or more protected processing environments.

129.   The method of Claim 127, in which the first portion of the first protected

information consists of the entirety of the first protected information.

130. The method of Claim 127, in which the first portion of the first protected information consists of less than the entirety of the first protected information.

131. The method of Claim 127, in which

the first memory is located at a first site,

the second memory is located at a second site remote from the first site, and

the step of copying or transferring the first portion of the first protected information to the second secure container further comprises copying or transferring the first protected information from the first site to the second site.

132. The method of Claim 127, in which the first memory and the second memory are located at the same site.

133. The method of Claim 132, in which the first memory comprises first addressable memory locations, and the second memory comprises second addressable memory locations in the same address space as the first addressable memory locations.

134.   The method of Claim 133, in which the first addressable memory locations and the second addressable memory locations are located within the same physical memory device.

135.   The method of Claim 127, in which the step of copying or transferring the first portion of the first protected information from the first secure container to the second secure container further comprises storing a third secure container in the second secure container.

136.   The method of Claim 127, further comprising:

> creating a third rule set.

137.   The method of Claim 136, further comprising:

> using the third rule set to govern at least one aspect of use of the copied first portion of the first protected information.

138.   A method for performing the following steps within a virtual distribution environment comprising one or more electronic appliances and a first secure container, the first secure container having associated a first control set and containing first protected information, the method comprising:

using a control from the first control set to govern an aspect of use of the first protected information while the first protected information is contained within the first secure container;

creating a second secure container having associated a second control set for governing an aspect of use of protected information contained within the second secure container;

incorporating a first portion of the first protected information in the second secure container, the first portion made up of some or all of the first protected information;

using a control to govern an aspect of use of the first portion of the first protected information while the first portion is contained within the second secure container; and

in compliance with a control, reporting information relating to the identification of the first portion of the first protected information to a remote site.

139. An electronic appliance comprising:

a memory storing a first secure container having associated a first rule set and containing first protected information; and

a secure processing unit comprising

means for creating a second secure container having

associated a second rule set, the means for creating further

comprising

means for copying or removing a first rule from the

first rule set, and

means for incorporating the first rule in the second

rule set;

means by which a rule from the first rule set governs, at least

in part, the means for creating the second secure container;

means for extracting at least a first portion of the first

protected information from the first secure container;

means for copying or transferring the first portion of the first

protected information from the first secure container to the

second secure container,

the means for copying or transferring operating at

least in part under the control of the first rule set or

the second rule set; and

means for storing identification information at least in part identifying the first portion and for communicating at least a portion of the identification information to a remote site.

REMARKS

The present application is a continuation of immediate parent application Ser. No. 09/335,465, filed June 17, 1999 ("the parent application"). With this continuation application, Applicants file this Preliminary Amendment adding new Claims 91-139, which correspond to Claims 91-105 and 114-147 from the parent application. In an Office action dated July 7, 2000 ("the Office Action"), in the parent application, the Examiner rejected claims 91-105, 114-117, and 121-147 under 35 U.S.C. § 102(b) as anticipated by U.S. Pat. No. 4,827,508 to Shear ("Shear '508"). Additionally, the Examiner rejected Claims 91-105 and 114-147 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,103,392 to Mori. To expedite prosecution, Applicants will address these rejections in this Preliminary Amendment.

Applicants disagree with the rejection of former Claims 91-105 (new Claims 91-105), 114-117 (new Claims 106-111) and 121-128 (new Claims 113-120) based on Shear '508. (We note that former Claims 118-20 (new Claims 110-112) were not rejected on the basis of Shear '508.) In particular, Applicants disagree with the Examiner's characterization of Shear '508 as teaching or disclosing the first and second secure containers specified in former Claim 91. As is specified in Claim 91, the first secure container contains the second secure

container, which in turns contains the first protected information. Nothing similar to this is recited or suggested in Shear '508.

Applicants also disagree with the rejection of former Claims 129-130 (new Claims 121-122) for the same reasons, since independent claim 129 (new Claim 121) includes each of the limitations discussed above in connection with Claim 91.

Applicants further disagree with the rejection of former Claims 131-134, 146, and 147 (new Claims 123-126, 138, and 139, respectively) for similar reasons. These claims require three containers, one of them being used to transfer information between the other two. Contrary to the Examiner's assertions, nothing like this is found in Shear '508.

Applicants disagree with the rejection of former Claims 135-145 (new Claims 127-137) for similar reasons. Former Claim 135 (new Claim 127) recites a first secure container that is stored in a first memory and a second secure container that is stored in a second memory. For at least this reason, Applicants disagree with the Examiner's assertion that a secure container in the claimed invention reads on storage medium 100, since storage medium 100, unlike a secure container, cannot obviously be stored in a memory.

Additionally, Applicants disagree with the rejection of former Claims 91-105 and 114-147 (new Claims 91-139) based on U.S. Patent No. 5,103,392 to Mori. As is described above, each of the independent claims requires multiple containers, as well as the incorporation of information from one of the secure containers into another of the secure containers. Mori neither discloses nor

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suggests anything resembling the claimed elements. Even assuming that the Mori program storage elements can constitute a secure container, Mori does not show the use of a secure container to transfer information between other secure containers.

Furthermore, Applicants note that the Examiner cited no specific support for the assertion that "[t]he recited second secure container reads on the program information being transferred or used at the user site." (Office Action at 3). Applicants note also that the Examiner provided no specific basis for the claim that "program information" constitutes a secure container. Indeed, Applicants were unable to find support in Mori for such statements and therefore respectfully submit that former Claims 91-105 and 114-147 (new Claims 91-139) are patentable over Mori.
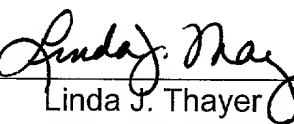
For at least the reasons above, Applicants respectfully suggest that new Claims 91-139 are patentable over Shear '508 and Mori, and respectfully request that the new claims be allowed as written.

If there are any other fees due in connection with the filing of this response, including fees for extension of time, please charge the fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: January 18, 2001   By: _____

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